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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,130	04/13/2000	Drago Borosic	98045 P US	7530

7590

07/29/2004

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EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/549,130

Applicant(s)

BOROSIC, DRAGO

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 9-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The response filed on April 22, 2004 has been entered.

Claim Rejections - 35 USC § 112

2. Claims 1-6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 3, the recitation "tissue sections" is vague as to whether it refers to that set forth in line 1 or to other such sections, and it seems that --said-- should be inserted before "tissue" or the like.

In claim 5, line 2, "that latches" is vague as to what it refers (i.e., what latches?).

In claim 6, lines 2-3, the recitation "such that said knife wherein the knife ..." is vague and indefinite as to what is being set forth.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1, 3-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by French Publication 2 549 098 (hereafter FP '098).

FP '098 discloses an apparatus with every structural limitation of the claimed invention including a disc-shaped cutting knife (e.g., 1); and a knife holder with a knife receiver (e.g., 2, 21), the knife receiver having a shaft (e.g., 22) and a rotatable mounting (e.g., 7), wherein the rotatable mounting has a positioning element (e.g., 8) and a detent (e.g., 15, which meets the claim limitations as broadly interpreted); and a releasable stop (e.g., 14).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over French Publication 2 549 098 (hereafter FP '098).

FP '098 lacks the knife holder having a depression in which the knife is received. However, the Examiner takes Official notice that such depressions are old and well known in the art and provide various well known benefits including acting as a guard to protect portions of the knife which are not being used as well as safety benefits. Therefore, it would have been obvious to one having ordinary skill in the art to provide a

depression in the knife holder of FP '098 for the well known benefits including those described above.

Response to Arguments

7. Applicant's arguments filed December 9, 2002 have been fully considered but they are not persuasive.

On page 6 of the amendment, applicant argues that the prior art, specifically FP '098 does not teach the limitations set forth in the preamble; specifically, a microtome for the production of tissue sections in histology, in which an object to be section is passed past a stationary knife for the production of tissue sections...". Rather, applicant argues that FP '098 discloses a thread cutting machine and thus does not deal with a microtome and tissue sections are not produced. The Examiner respectfully disagrees with applicant's analysis. It is respectfully submitted that the prior art, specifically FP '098 teaches or suggests all of the structure set forth in the body of the claims. It is not at all clear to what extent additional structure is or should be imported by the recitation of "microtome" in the preamble. However, since the prior art meets the structure set forth in the body of the claims, the prior art is considered to meet the claimed invention. It is further noted that the recitation that the invention is used to cut tissue sections appears to be a functional recitation of intended use. And, as is well settled, such an intended use cannot be relied upon to distinguish a claimed invention over the prior art. Further, applicant refers to the stationary knife set forth in the preamble and argues that the prior art does not disclose a stationary knife. However, the Examiner respectfully

submits that there is no positive relationship established in the claims between the stationary knife of the preamble and the disk-shaped knife set forth in the body of the claims. Thus, the relationships established for the stationary knife in the preamble are not necessarily related to the disk-shaped knife set forth in the body of the claims. For at least these reasons, it is respectfully submitted that the prior art rejection must be maintained.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (703)308-

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1404. The examiner can be reached Monday through Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (703)308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
July 23, 2004